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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES B. KUYKENDALL and
THOMAS G. CLEVELAND JR.

Appeal 2009-006567
Application 09/929,460
Technology Center 3600

Decided: October 27, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James B. Kuykendall, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-10 and 26-30. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to remote fund transfers.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A system for performing push-model fund transfers between at least one user and at least one payor, the system comprising:
 - at least one payor interface comprising software operative to permit the at least one payer to provide information identifying a desired fund transfer;
 - a gateway having at least one gateway account, said gateway being operative:
 - to receive said information;
 - to receive incoming funds from the payor via a push-model transfer into said at least one gateway account after receiving said information;
 - to inform the user that the payor has provided an appropriate amount of funds via a push-model transfer if said

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Aug. 25, 2008) and Reply Brief ("Reply Br.," filed Jan. 21, 2009), and the Examiner's Answer ("Answer," mailed Nov. 18, 2008).

incoming funds received are of an appropriate amount according to said desired fund transfer; and
to send corresponding outgoing funds to the user after receiving said incoming funds.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Jennings	US 5,659,165	Aug. 19,1997
Elgamal	US 6,138,107	Oct. 24, 2000

The following rejections are before us for review:

1. Claims 1-10 and 26-28 are rejected under 35 U.S.C. §102(e) as being anticipated by Elgamal.
2. Claims 28-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Elgamal and Jennings.

ISSUES

Have the Appellants shown error in the rejections of claims 1-10 and 26-28 under 35 U.S.C. §102(e) as being anticipated by Elgamal and claims 28-30 under 35 U.S.C. §103(a) as being unpatentable over Elgamal and Jennings?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer (Ans. 3-6) and Final Office Action (2-5).

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-10 and 26-28 under 35 U.S.C. §102(e) as being anticipated by Elgamal.

The Appellants argued claims 1-10 as a group (App. Br. 8-10 and Reply Br. 4-5). We select claim 1 as the representative claim for this group, and the remaining claims 2-10 and 26-28 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants have not shown error in the rejection. “Many of appellants’ arguments fail from the outset because, . . . they are not based on limitations appearing in the claims.” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The Appellants argue two distinctions over Elgamal.

According to the Appellants, the claimed invention involves “real” funds (Reply Br. 4: “[in Elgamal] real funds are not even transferred directly to the PG; rather, electronic money is credited to the PG’s EMA.”) rather than “virtual” funds (Reply. Br. 4: “there is not so much as a hint that it [*i.e.*, Elgamal] could support transactions by means other than drawing down the virtual funds”). *See also* App. Br. 8 (“real” currency vs. Elgamal’s “pseudo-currency”). However, claim 1 makes no distinction as to the type of funds. Throughout the claim the term “funds” is used without qualification. There is neither an express definition in the Specification for “funds” to narrow the construction to be given the claim term “funds” nor does the subject matter as claimed limit the scope of the “funds” used to that which is “real” in contrast to “virtual.” Accordingly, this argument is not persuasive as to error in the rejection.

The Appellants also argue that Elgamal does not describe the use of push-model transfers. App. Br. 10 and Reply Br. 4. According to the Appellants, the use of the terms “push-model” in the claim limits the claimed subject matter “to systems in which the transactions are push-model

transfers of actual funds - not merely an extension of debits and credits by a private entity, as in Elgamal” (Reply Br. 4). The principle difficulty with this argument is that the Appellants do not explain in what way the claim terms “push-model” limits the scope of the claimed subject matter to transfers of “actual” funds. The Appellants have not pointed to an express definition in the Specification or presented evidence of knowledge in the art at the time of the invention to support narrowing the scope of the claimed subject matter to the use of “actual” funds. Accordingly, this argument is not persuasive as to error in the rejection.

The Appellants also discuss various advantages for the claimed invention to suggest that Elgamal would not accomplish. For example, “[a]nother advantage of the instant invention is improved privacy and security, because the payor need not provide information identifying his or her bank account, credit card number, or such information.” App. Br. 9. Be that as it may, claim 1 does not limit the information the payor provides. Moreover, claim 1 (as with all the claims on appeal) is directed to a system. Claim 1 defines the system as one “for performing push-model fund transfers between at least one user and at least one payor” and which comprises two elements: (1) “at least one payor interface comprising software operative to permit the at least one payer to provide information identifying a desired fund transfer” and (2) “a gateway having at least one gateway account.” Claim 1 expresses these two elements in terms of function only. The Appellants do not appear to dispute that Elgamal describes these two elements. Accordingly, the question of anticipation turns on whether Elgamal describes, expressly or inherently, a system capable of performing the functions recited in the claim for these two

elements. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). In that regard, the Appellants have not explained in what way Elgamal fails to describe, expressly or inherently, a system where these two elements are capable of performing the functions recited in the claim, notwithstanding the advantages alleged to flow from the invention.

The Appellants have not shown error in the rejection of claims 1-10 and 26-28 under §102 over Elgamal.

The rejection of claims 28-30 under 35 U.S.C. §103(a) as being unpatentable over Elgamal and Jennings.

The Appellants argued claims 28-30 as a group (App. Br. 10-12; Reply Br. 4-5). We select claim 28 as the representative claim for this group, and the remaining claims 29 and 30 stand or fall with claim 28. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The arguments against this rejection are unpersuasive as to error in the rejection because, as with the arguments challenging the 102 rejection, they are not commensurate in scope with what is claimed. For example, the Appellants argue that “as discussed above with respect to the rejections under 35 U.S.C. § 102, the prior art does not teach or suggest a system that uses the deposit of actual funds through a push-model transfer, such that a private, secure, and final transaction can be accomplished much more quickly than in the prior art” (App. Br. 10-11). However, there is nothing in claim 28 that calls for the use of a deposit of “actual” funds. Claim 28 further defines the payer interface as comprising a transaction reviewer having certain capabilities. Claim 28 does not require using a deposit of “actual” funds.

The Appellants also argue that “[n]o suggestion or motivation to modify Elgamal to produce the claimed invention has been found or cited”. App. Br. 12. In point of fact, the Examiner *did* present a motivation. See Answer 6: “[o]ne would have been motivated to do so in order to automatically compute appropriate exchange rate and display them to the user for user’s authorization.” Accordingly, in contradistinction the Appellants’ argument, the Examiner did provide an apparent reasoning for the legal conclusion of obviousness.

The Appellants have not shown error in the rejection of claims 28-30 under §103 over Elgamal and Jennings.

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-10 and 26-28 under 35 U.S.C. §102(e) as being anticipated by Elgamal and claims 28-30 under 35 U.S.C. §103(a) as being unpatentable over Elgamal and Jennings.

DECISION

The decision of the Examiner to reject claims 1-10 and 26-30 is affirmed.

AFFIRMED

mev

Appeal 2009-006567
Application 09/929,460

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